

AMENDMENT UNDER 37 C.F.R. § 1.111  
Appln. No. 09/987,086  
Docket No. Q67205

### **REMARKS**

Claims 1-10 are all the claims pending in the application. Claims 1 and 6 are independent claims.

As an initial matter, pending dependent claims 4 and 9 are not subject to a prior art rejection. Therefore, Applicants respectfully request the Examiner to allow the claims.

#### **Restriction**

With respect to withdrawn claims 11-13, Applicants are not aware of any requirement that Applicants must cancel the withdrawn claims at this time. However, for the convenience of the Examiner, Applicants have canceled withdrawn claims 11-13 without prejudice or disclaimer.

#### **Drawings**

The Examiner has objected to claim 2, alleging that the feature of the “holding portion” is not shown in the drawings. In response, Applicants have amended claim 2 to replace the recitation “holding portion” with the recited “support portion”, which has an antecedent in claim 1. In view of this amendment, Applicants respectfully request the Examiner to withdraw Examiner’s objection.

#### **Claim Rejections Under 35 U.S.C. § 103**

Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over newly cited Nagata et al. (US 5,486,054) in view of Asai (Japanese Patent Publication No. 64-30436) and Kawanishi (US 5,886,438).

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Independent claims 1 and 6 have been amended to recite that the positional regulation part and the support portion are both integrally formed with said resin coil bobbins by insert molding. This amendment is fully supported by the original specification at least by the non-limiting embodiment discussed at page 8, lines 23-24 and page 10, lines 3-6.

Applicants respectfully request the Examiner to withdraw the rejection of independent claims 1 and 6 at least because the combination of Nagata, Asai, and Kawanishi does not teach or suggest the claimed motor. For example, the combination of Nagata, Asai, and Kawanishi does not teach or suggest a motor having the positional regulation part and support portion *integrally formed with said resin coil bobbins by insert molding*. By proving a resin coil bobbin-positional regulation part-support portion integrally formed by insert molding, the dimensional accuracy of the claimed motor is assured.

None of the applied references teaches or suggest a motor having this feature. For example, even assuming *arguendo* that Nagata's mounting plate 3 and bushing 17 (alleged as corresponding to the claimed positional regulation part) are integrally formed with the bobbin portion of the stator 2, these portions are clearly not integrally formed *by insert molding*.

In addition, there is no motivation or suggestion to modify Nagata's structure so that portions are integrally formed by insert molding.

First, although the Office Action dated August 30, 2002 referred to *Howard v. Detroit Stove Works*, 150 U.S. 164 (1983) for the allegation that forming a one piece article involves only routine skill in the art, as discussed at MPEP §2144.4, it is not appropriate to rely solely on

case law as the rationale to support an obviousness rejection if the applicant has shown a criticality of a specific limitation. As is discussed above, the fact that the claimed invention provides a positional regulation part and support portion that are integrally formed with said resin coil bobbins by insert molding provides a motor with dimensional accuracy assured. As such, any reliance by the Examiner on *Howard* as the sole source of a motivation or suggestion is improper.

In addition, in the Office Action dated March 18, 2002, the Examiner did not give any patentable weight to the recitation that the coil bobbin is formed by insert molding. Specifically, the Examiner cited *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 968 (Fed. Cir. 1985) for the allegation that the patentability of a product does not depend on the product's method of production. In *Thorpe*, the product claim was rejected because the court determined that the end product in the prior resulting from the asserted method and the prior art end product were the same. See discussion at MPEP §2113.

In contrast, the claimed motor having a positional regulation part and support portion that are integrally formed with said resin coil bobbins by insert molding clearly imparts distinctive *structural characteristics* to the final integrally formed resin coil bobbin-positional regulation part- support portion. For example, an integrally molded structure is clearly structurally distinct from a structure that is, for example, made up of separate pieces that are connected together. As such, the fact that that the coil bobbin-positional regulation part-support portion of the claimed invention is integrally formed by insert molding must be considered when assessing the

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patentability of the invention. MPEP §2113; *In re Garnero*, 412 F.2d 276, 162 USPQ 221 (CCPA 1979).

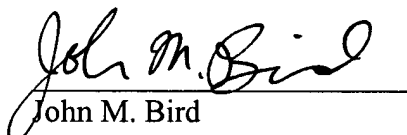
As such, for at least the reasons discussed above, Applicants respectfully request the Examiner to withdraw the rejection of independent claims 1 and 6. In addition, Applicants respectfully request the Examiner to withdraw the rejection of claims 2, 3, 5, 7, 8, and 10 at least because of their dependency from one of claims 1 and 6.

#### Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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